

PATENT

Docket No. RSW920000148US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: Michael D. Rahn and David B. Lection

Examiner: Y. Pan

Art Unit: 2682

APPLICATION NO. 09/772,455

FILED: January 29, 2001

**TITLE: CORDLESS COMMUNICATION BETWEEN PDA AND HOST
COMPUTER USING CRADLE**

FILED ELECTRONICALLY ON October 17, 2006

Commissioner for Patents
MAIL STOP APPEAL BRIEF-PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

APPELLANTS' BRIEF

This brief is being resubmitted in response to the Notice of Noncompliant Appeal Brief, dated September 18, 2006. It is a resubmission of the Appeal Brief filed on March 8, 2006 in response to a Notice of Non-Compliant Appeal Brief, and which was originally filed on February 28, 2005, along with a Petition for Extension of Time, and the required fees. **The Appeal Brief filing fee was already charged to Applicant's Deposit Account when the original Brief was filed on February 28, 2005.** Any additional fees are authorized to be charged to Deposit Account No. 09-0461.

1. REAL PARTY IN INTEREST

The present application is assigned to International Business Machines Corporation, having its principal place of business at New Orchard Road, Armonk, New York 10504. Accordingly, International Business Machines Corporation is the real party in interest.

2. RELATED APPEALS AND INTERFERENCES

The appellant, assignee, and the legal representatives of both are unaware of any other appeal or interference which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

3. STATUS OF CLAIMS

- A. Claims canceled: 1-35, and 39
- B. Claims withdrawn from consideration but not canceled: None
- C. Claims pending: 36-38 and 40-49
- D. Claims allowed: none
- E. Claims rejected: 36-38 and 40-49
- F. Claims appealed: 36-38 and 40-49

Appealed claims 36-38 and 40-49 as currently pending are attached as the Claims Appendix hereto.

4. STATUS OF AMENDMENTS

No amendment after final was filed in the present case. A Reply under 37 C.F.R. §1.111 was filed on February 6, 2004 and resulted in the final Office Action appealed herein. A Reply under 37 CFR §1.116 was filed on June 23, 2004, but did not result in allowance by the Examiner.

5. SUMMARY OF THE CLAIMED INVENTION

Claim 36: A cordless method for communication between a host computer and at least one portable communications device using a docking device, wherein the docking device is connectable to the host computer and capable of synchronizing the portable communications device and the host computer when the communications device is docked in the docking device, the method comprising: communicating a signal between the host computer and the portable communications device through the docking device without docking of the portable communications device in the docking device, using cordless spread spectrum radio technology (*page 5, lines 6-19; page 6, line 4-page 7, line 8*).

Claim 45: A computer program product embodied on computer readable media readable by a computing device, the product comprising: computer-readable program code means for providing personal digital assistant (PDA) functions to a portable communications device (*page 10, line 10-page 13, line 14*); and computer-readable

program code means for configuring a host computer and the portable communications device to perform cordless communication each other through a docking device without requiring docking of the portable communications device in the docking device (*page 10, line 10-page 13, line 14*).

Claim 48: A cordless method for providing chat communication between a host computer and at least one portable communications device using a docking device, wherein the docking device is connectable to the host computer and capable of synchronizing the portable communications device and the host computer when the communications device is docked in the docking device, the method comprising: establishing a communication between a chat program on the host computer and a chat program on the portable communications device, via the docking device, without docking of the portable communications device in the docking device, using cordless spread spectrum radio technology (*page 11, lines 1-8*).

Claim 49: A cordless method for providing email communication between a host computer and at least one portable communications device using a docking device, wherein the docking device is connectable to the host computer and capable of synchronizing the portable communications device and the host computer when the communications device is docked in the docking device, the method comprising: establishing a communication between an email program on the host computer and an email program on the portable communications device, via the docking device, without docking of the portable communications device in the docking device, using cordless spread spectrum radio technology (*page 11, lines 1-8*).

The present invention is a method for cordless communication between a personal digital assistant (PDA) and a host device, such as a computer. In a preferred embodiment, a docking cradle is configured to facilitate the transmission/receipt of chat and email communications between the PDA and the host device, using cordless spread spectrum radio technology for the communication link between the PDA and the docking cradle. The communication link between the docking cradle and the host computer takes place via the wired connection between the cradle and the host computer.

Cordless spread spectrum radio technology requires no access to traditional wireless carriers such as cellular telephone service. Using the present invention, one or more PDAs can carry on email communications and/or chat communications with an email or chat program on the host computer, using the cordless spread spectrum radio technology provided by the specialized docking cradle.

U.S. Patent No. 6,556,826 to Johnson et al.

U.S. Patent No. 6,556,826 to Johnson et al. ("Johnson") teaches a communication interface system whereby a communication device includes interface capability for multiple devices. The communication interface of Johnson includes a docking interface, a wireless interface, a telephone interface, and a computer interface and devices such as a PDA, a telephone, and a computer system all are able to communicate with a network via the communication interface.

U.S. Patent No. 6,278,725 to Rouphael et al.

U.S. Patent No. 6,278,725 to Rouphael et al. teaches a Rake receiver having fingers. The Rake receiver includes frequency discriminators for automatic frequency control and a combiner. The Examiner relies upon Rouphael for an alleged teaching of the use of spread spectrum technology in cellular and cordless communications systems.

U.S. Patent No. 6,119,179 to Whitridge et al.

U.S. Patent No. 6,119,179 to Whitridge et al. teaches a portable adaptor that provides non-repudiable telecommunications services to barcode reading hand-held computers and palm-top or table-type mobile computers. The Examiner relies upon Whitridge for an alleged teaching of the establishment of communication between a chat program and an email program on a host computer and a program on a portable communication device.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Applicant requests reconsideration of the finality of the present rejection.

B. Applicant requests the Board to review the rejection of claims 36-38 and 40-47 under 35 U.S.C. §103 based on U.S. Patent No. 6,556,826 to Johnson et al. in view of U.S. Patent No. 6,278,725 to Rouphael et al.

C. Applicant requests the Board to review the rejection of claims 48-49 under 35 U.S.C. §103 based on Johnson et al. in view of Rouphael et al. and further in view of U.S. Patent No. 6,119,179 to Whitridge et al.

7. ARGUMENT

A. The Final Rejection Was Premature

Applicant requests reconsideration of the finality of the present rejection. The Examiner indicates that the claim amendments submitted by applicant necessitated the new grounds of rejection. This is incorrect. The amendment to claim 36 is simply the inclusion of the substantive limitations of previously-presented claim 39 and is thus substantively identical to claim 39. This amendment should not have been the basis for a new search. In the previous Office Action, the Examiner rejected claim 39 under 35 U.S.C. §102 based on Johnson et al. In the present Office Action, the

October 17, 2006

Examiner rejected claim 36, which is substantively identical to claim 39, based on the combination of Johnson and Roupheal et al.

Applicant acknowledges that the word "cordless" was added when including the limitations of claim 39 in claim 36. While this changes the exact wording of claim 39, it does not change the substance of claim 39. Specifically, spread spectrum radio technology is, by definition, a cordless technology. In other words, there is no such thing as spread spectrum technology used over a wired communication link. Applicant simply included the word "cordless" for the purpose of consistency with the rest of the claim. However, the addition of the word "cordless" does not present any new search issues for the Examiner.

Applicant has not been afforded an opportunity to rebut the assertions of the Examiner and thus, making of the rejection final is premature. Accordingly, the Board is respectfully requested to reconsider and withdraw the finality of the Office Action.

B. The Examiner has not Established a *prima facie* Case of Obviousness with respect to the rejection of claims 36-38 and 40-47 under 35 U.S.C. §103 based on U.S. Patent No. 6,556,826 to Johnson et al. in view of U.S. Patent No. 6,278,725 to Roupheal et al.

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

MPEP 2143

The Examiner has not met this burden. The present invention allows a user of a portable device, such as a PDA, to communicate with a host computer via a cradle for the PDA or communication device, that is, the PDA and the docking device are configured to be able to communicate with each other via cordless spread spectrum radio technology, a localized form of cordless radio technology utilized by cordless phones (as distinct from cellular technology, which is also cordless). The cradle then facilitates the completion of the communication path to the host device using the wire connecting the cradle to the host device. This allows the user to communicate, on a local level, between the PDA and the host computer using both the cordless receiving and transmitting capability of the cradle and its wired receiving and transmitting capability. It should be understood that this localized communication is significantly different than the cellular communication that is typically used for communication between a PDA and a host computer.

Johnson teaches a communication interface system whereby a communication device includes interface capability for multiple devices. Johnson teaches both a PDA cradle and wireless interface (docking interface 302 and wireless interface 303 of Figure 3). The wireless interface 303 is the typical long-distance wireless cellular interface used for connecting a PDA to a host computer, typically via cellular technology. The connection between the PDA and the host device is entirely wireless. Johnson also suggests the combining of the docking interface and the wireless interface into a single unit. However, this suggested combination, at best, merely

teaches the use of the cradle (the docking interface) as a support vehicle or support structure for the wireless cellular interface, that is, while there is structural coupling between the two elements, there is no operable coupling of the two elements taught or suggested by Johnson. At no time (while the PDA is not in the docking interface) is the cordless communication between the PDA and the host device facilitated by the wired connection between the docking interface and the host device. They work independently of each other but are combined in a single structure for convenience.

The present invention specifically recites the requirement that the communication of a signal between the host computer and the portable communication device occurs through the docking device, and that such communication uses cordless spread spectrum radio technology. The Examiner admits that Johnson does not teach the use of cordless spread spectrum technology as a means for communicating between a PDA and a host device via a docking device.

The addition of Rouphael does not provide the necessary teaching, nor suggestion, to support the rejection made by the Examiner. The portion of Rouphael relied upon by the Examiner for this alleged teaching and suggestion is as follows:

"Illustratively, the Rake receiver 200 is used for wireless telephones or handsets with code division multiple access (CDMA) modulation, such as cellular CDMA phones or cordless spread spectrum phones." Rouphael, column 7, lines 11-14.

This is clearly not a teaching or suggestion of using cordless spread spectrum technology to communicate locally between a handheld device and a host computer via a cradle that is also usable for holding the handheld device; the Examiner's reliance on

Rouphael is simply impermissible hindsight. Without any teaching or suggestion of a motivation to combine the references as suggested by the Examiner, the combination is improper for use as a rejection under 35 U.S.C. §103. Accordingly, the Board is respectfully requested to reconsider and withdraw the rejection of claims 36-38 and 40-47 under 35 U.S.C. §103.

C. The Examiner has not Established a *prima facie* Case of Obviousness with respect to the rejection of claims 48-49 under 35 U.S.C. §103 based on Johnson et al. in view of Rouphael et al. and further in view of U.S. Patent No. 6,119,179 to Whitridge et al.

The addition of Whitridge et al. does not render claims 48 and 49 unpatentable. As noted above, neither Johnson nor Rouphael teach or suggest the ability to provide localized communication between a handheld device and a host computer via a cradle designed to hold the handheld device, nor do they teach or suggest such communication using cordless spread spectrum technology. The Examiner relies on Whitridge for an asserted teaching of the establishment of a communication between a chat program and/or an email program on a host computer and a chat program and/or email program on a portable communication device. Applicant does not claim to have invented the use of handheld devices for conducting chat or email communications. However, nothing in Whitridge teaches or suggests the use of cordless spread spectrum radio technology to provide localized communication, including chat or email, between a handheld device and a host computer via a cradle designed for holding the handheld device, using cordless spread spectrum technology. Thus, the rejection of

October 17, 2006

claims 48 and 49 based on the combination of Johnson, Rouphael and Whitridge is inappropriate and should be withdrawn. The Board is respectfully requested to reconsider and withdraw the rejection of claims 48 and 49 under 35 U.S.C. §103.

8. CONCLUSION

For the foregoing reasons applicants respectfully request this Board to overrule the Examiner's rejections and allow claims 36-38 and 40-49.

Respectfully submitted:

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Date

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CLAIMS APPENDIX

CLAIMS INVOLVED IN THIS APPEAL:

Claims 1-35 (Canceled)

36. (Previously presented) A cordless method for communication between a host computer and at least one portable communications device using a docking device, wherein the docking device is connectable to the host computer and capable of synchronizing the portable communications device and the host computer when the communications device is docked in the docking device, the method comprising:

communicating a signal between the host computer and the portable communications device through the docking device without docking of the portable communications device in the docking device, using cordless spread spectrum radio technology.

37. (Original) The method of claim 36, wherein the docking device includes a first antenna and the portable communications device includes a second antenna, and wherein the communicating step communicates the signal through the first and second antennas.

38. (Original) The method of claim 36, wherein the communicating step communicates the signal using predetermined security keys.

39. (Canceled)

40. (Original) The method of claim 36, wherein the portable communications device is a personal digital assistant (PDA).

41. (Original) The method of claim 40, wherein the communicating step communicates the signal from the host computer to a plurality of PDAs, simultaneously, using a set of predetermined security keys commonly assigned to the PDAs.

42. (Original) The method of claim 40, wherein the communicating step selectively communicates the signal from the host computer to a plurality of PDAs using different sets of predetermined security keys assigned to the PDAs.

43. (Original) The method of claim 40, wherein the PDA provides telephone functions.

44. (Original) The method of claim 36, further comprising:
relaying communication from one portable communications device to another portable communications device using a list of device identifiers for identifying different portable communications devices.

45. (Original) A computer program product embodied on computer readable media readable by a computing device, the product comprising:

computer-readable program code means for providing personal digital assistant (PDA) functions to a portable communications device; and

computer-readable program code means for configuring a host computer and the portable communications device to perform cordless communication each other through a docking device without requiring docking of the portable communications device in the docking device.

46. (Original) The product of claim 45, further comprising:

computer-readable program code means for generating a set of security keys to be used in the cordless communication.

47. (Original) The product of claim 46, further comprising:

computer-readable program code means for providing data synchronization between the host computer and the portable communications device when the communications device is docked in the docking device.

48. (Previously presented) A cordless method for providing chat communication between a host computer and at least one portable communications device using a docking device, wherein the docking device is connectable to the host computer and capable of synchronizing the portable communications device and the host computer

when the communications device is docked in the docking device, the method comprising:

establishing a communication between a chat program on the host computer and a chat program on the portable communications device, via the docking device, without docking of the portable communications device in the docking device, using cordless spread spectrum radio technology.

49. (Previously presented) A cordless method for providing email communication between a host computer and at least one portable communications device using a docking device, wherein the docking device is connectable to the host computer and capable of synchronizing the portable communications device and the host computer when the communications device is docked in the docking device, the method comprising:

establishing a communication between an email program on the host computer and an email program on the portable communications device, via the docking device, without docking of the portable communications device in the docking device, using cordless spread spectrum radio technology.

EVIDENCE APPENDIX

No evidence is presented.

RELATED PROCEEDINGS APPENDIX

No related proceedings are presented.